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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,218	04/12/2004	C. Douglass Thomas	IPVMAP01	1308

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IPVENTURE, INC.  
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EXAMINER

VUONG, QUOCHIE B

ART UNIT PAPER NUMBER

2618

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/822,218	Applicant(s) THOMAS ET AL.	
	Examiner Quochien B. Vuong	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-20 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 22 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/10/06</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action in response to applicant's response filed on 04/05/2006. Claims 1-20 are now pending in the present application. **This action is made final.**

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "said at least one operation indicator" in claim 10, lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.

It is noted that the limitation "at least one operator indicator" is first introduced in claim 9. therefore, claim 10 should depend on claim 9 instead of claim 7.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swab et al. (US 6,929,365) in view of Jesiek (US 6,010,216) and Rydbeck (US 5,590,417).

Regarding claim 1, Swab et al. (figures 1, 2a, and 3) disclose a pair of eyeglasses, comprising a frame having a pair of arms and a pair of lense holders (figures 1 and 2a), one or both of the arms having an internal area; wireless communication circuitry (figure 3) provided within the internal area of one or both of the arms; at least one speaker (56) coupled to the wireless communication circuitry, at least a portion of the speaker being provided within the internal area of at least one of the two arms; at least one microphone(54) coupled to the wireless communication circuitry, wherein the at least a portion of one microphone being embedded in the frame; at least one battery (52) for powering at least the wireless communication circuitry, wherein the at least one battery is provided within the internal area of at least one of the arms, wherein the at least one battery is provided internal to a first of the arms (column 4,

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lines 5-18; column 4, line 66- column 5, line 43; and column 5, line 66 – column 6, line 16). Swab et al. do not specifically disclose the pair of eyeglasses comprising a balancing weight provided internal to the internal area of at least one of the arms, and wherein the balancing weight is provided internal to a second of the arms so that the two arms are of substantially the same weight, and wherein the at least one battery is rechargeable. However, Swab et al. do disclose balancing weight for the eyeglasses frame (column 5, line 36-41) by putting battery on one arm and the other circuitry on the other arm. Therefore, it would have been obvious to put an additional balancing weight to one or the other arm when necessary for the same purpose of balancing the weight of the eyeglasses to provide comfort the user. And Jesiek discloses a hands free two-way radio communications in the eyeglasses with rechargeable batteries (column 1, lines 46-61; and figures 1 and 2). Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to adapt the rechargeable batteries of Jesiek to the eyeglasses of Swab et al. in order to save cost by reusing the rechargeable batteries.

Regarding claims 2-7, Swab et al. disclose at least one speaker coupled to the arm of the eyeglasses (figure 8) (column 7, lines 11-23); and if not inherent it would be obvious for the at least one speaker of Swab et al. to be arranged as in claims in order to be in the arm of the eyeglasses and provide communication function to the user.

Regarding claim 8, since the eyeglasses of Swab et al. and Jesiek comprising the rechargeable batteries, it would be obvious for the eyeglasses of Swab et al. and

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Jesiek to include a power adapter connector in order to charge the rechargeable batteries without removing the batteries from the eyeglasses.

6. Claims 9-12 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swab et al. in view of Jesiek and further in view of Horiguchi (US 7,031,667).

Regarding claim 9-12, Swab et al. and Jesiek do not specifically disclose the eyeglasses further comprise at least one light source operation indicator for indicating the operating and that the wireless communication circuitry is in use. However, Horiguchi disclose a portable telephone (figure 2) comprising at least one light source operation indicator for indicating the operating and that the wireless communication circuitry is in use (see abstract; column 3, lines 28-45; and column 5, lines 16-58). Therefore it would have been obvious to adapt the at least one light source operation indicator of Horiguchi to the eyeglasses of Swab et al. and Jesiek in order to provide visual indication of the operating state of the communication circuitry of the eyeglasses to the user.

Regarding claim 15, Swab et al. (figures 1, 2a, and 3) disclose a pair of eyeglasses, comprising: a frame having a pair of arms and a pair of lense holders (figures 1 and 2a), one or both of the arms having an internal area; wireless communication circuitry (figure 3) provided within the internal area of one or both of the arms; at least one speaker (56) coupled to the wireless communication circuitry; at least one microphone(54) coupled to the wireless communication circuitry; at least one

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battery (52) for powering at least the wireless communication circuitry, wherein the at least one battery is provided within the internal area of at least one of the arms (column 4, lines 5-18; column 4, line 66- column 5, line 43; and column 5, line 66 – column 6, line 16). Swab et al. do not specifically disclose the pair of eyeglasses comprising at least one operation indicator configured to indicate an operation of the wireless communication circuitry, and wherein the at least one battery is rechargeable. However, Jesiek discloses a hands free two-way radio communications in the eyeglasses with rechargeable batteries (column 1, lines 46-61; and figures 1 and 2). Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to adapt the rechargeable batteries of Jesiek to the eyeglasses of Swab et al. in order to save cost by reusing the rechargeable batteries. And Horiguchi disclose a portable telephone (figure 2) comprising at least one light source operation indicator for indicating the operating and that the wireless communication circuitry is in use (see abstract; column 3, lines 28-45; and column 5, lines 16-58). Therefore it would have been obvious to adapt the at least one light source operation indicator of Horiguchi to the eyeglasses of Swab et al. and Jesiek in order to provide visual indication of the operating state of the communication circuitry of the eyeglasses to the user.

Regarding claims 16-18, Horiguchi discloses the at least operation indicator is a light source to provide the operation state and that the wireless communication circuitry is in use (see abstract; column 3, lines 28-45; and column 5, lines 16-58).

7. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swab et al. in view of Jesiek and further in view of Spitzer (US 6,091,546).

Regarding claims 13 and 14, Swab et al. and Jesiek do not specifically disclose the eyeglasses further comprising a position sensor provided within the internal area of at least one of the arms. However, Splitzer discloses an eyeglasses interface system comprising a position sensor provided within the internal area of at least one of the arms (column 11, lines 11-23). Therefore, it would have been obvious to adapt the position sensor of Splitzer to the eyeglasses of Swab et al. and Jesiek in order to provide the location information to the user.

8. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swab et al. in view of Jesiek and and Horiguchi and further in view of Spitzer.

Regarding claims 19 and 20, Swab et al., Jesiek, and Horiguchi do not specifically disclose the eyeglasses further comprising a position sensor provided within the internal area of at least one of the arms. However, Splitzer discloses an eyeglasses interface system comprising a position sensor provided within the internal area of at least one of the arms (column 11, lines 11-23). Therefore, it would have been obvious to adapt the position sensor of Splitzer to the eyeglasses of Swab et al., Jesiek, and Horiguchi in order to provide the location information to the user.

### ***Response to Arguments***

9. Applicant's arguments filed 04/05/2006 have been fully considered but they are not persuasive.



Regarding claim 1, Applicant argues that Swab et al. and Jesiek fail to teach a “balancing weight provided within the internal area of at least one of said arms” and “wherein said at least one battery is provided internal to a first of said arms, wherein said balancing weight is provided internal to a second of said arm so that the two arms are of substantially the same weight”. The examiner, however, does not agree with the Applicant. Applicant’s attention is directed to Swab et al. (column 5, line 36-41) which discloses balancing weight for the eyeglasses frame by putting battery on one arm and the other circuitry on the other arm. Therefore, it would have been obvious to put an additional balancing weight to one or the other arm when necessary to the eyeglasses of Swab et al. for the same purpose of balancing the weight of the eyeglasses to provide comfort the user.

### ***Conclusion***

10. Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quochien B. Vuong whose telephone number is (571) 272-7902. The examiner can normally be reached on M-F 9:30-18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



QUOCHIE B. VUONG  
PRIMARY EXAMINER

Quochien B. Vuong  
June 07, 2006.